THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte MICHAEL D. KOTZIN

Appeal No. 96-4012
Application No. 08/197,908[1]

ON BRIEF

Before URYNOWICZ, BARRETT and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-26, all of the claims pending in the present application. An amendment after final rejection was filed November 24, 1995 which was denied entry by the Examiner.

[1] Application for patent filed February 17, 1994.

The claimed invention relates to the reduction of audio degradation in a communication system.

Claims 1 and 9 are illustrative of the invention and read as follows:

1. A method of mitigating audio degradation in a communication system, the method comprising the steps of:

accepting an audio information signal;

classifying the audio information signal based on a characteristic of the audio information signal; and

selectively coding said audio information signal according to a coding algorithm associated with the characteristic.

9. A method of mitigating audio degradation in a communication system, the method comprising the steps of:

accepting an audio information signal;

coding said audio information signal into a plurality of digitally compressed representations;

determining, for each of the digitally compressed representations, a quality characteristic; and

selecting, based on said quality characteristic, which of said digitally compressed representations to utilize.

The Examiner relies on the following references:

Galand	4,589,130	May 13, 1986
Hluchyj et al. (Hluchyj)	5,115,429	May 19, 1992

The rejections of the appealed claims are set forth by the Examiner as follows:

1. Claims 9-13 and 22-26 stand finally rejected under 35 U.S.C. § 102(b) as being anticipated by Galand.

2. Claims 1-26 stand finally rejected under 35 U.S.C. § 103 as being unpatentable over Hluchyj in view of Galand.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Brief[2] and Answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the Examiner, the arguments in support of the rejections and the evidence of anticipation and obviousness relied upon by the Examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellant's arguments set forth in the Brief along with the Examiner's rationale in

[2] Appellant filed a Supplemental Appeal Brief (February 19, 1999, paper no. 15) to correct the original non-compliant Appeal Brief filed on May 10, 1996 (paper no. 12). We will refer to the arguments in the original Appeal Brief as simply the Brief.

support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the disclosure of Galand fully meets the invention as recited in claims 9-13 and 22-26. We are also of the view that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention set forth in claims 9-13 and 22-26. We reach the opposite conclusion with respect to claims 1-8 and 14-21. Accordingly, we affirm-in-part.

We consider first the rejection of claims 9-13 and 22-26 under 35 U.S.C. § 102(b) as anticipated by Galand. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Assoc, Inc. v.

Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

We note that, at page 7 of the Brief, Appellant has grouped together the claims subject to this rejection and, consistent with this grouping, has made no separate arguments with respect to any of the claims within this group. As to Appellant's listing on pages 4-7 of the Brief of an indication of what each claim recites, we further note that simply pointing out what the claims require with no attempt to point out how the claims patentably distinguish over the prior art does not amount to a separate argument for patentability. In re Nielson, 816 F. 2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). Accordingly, all of the claims in this group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

With respect to independent claim 9, which we will choose as the representative claim for this group, the Examiner has indicated how the various limitations are read on the disclosure of Galand (Answer, pages 3 and 4). In response, Appellant's arguments (Brief, pages 8-10) center on the

alleged deficiency of Galand in disclosing the utilization of a plurality of coders on a source signal. In addition, Appellant contends that Galand is not concerned with the problem of speech degradation due to tandem coding.

After careful review of Appellant's arguments, it is our view that such arguments are not commensurate with the scope of independent claim 9. It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). The present claim 9 does not recite the use of a plurality of coders applied to a signal source as argued by Appellant. Rather, claim 9 recites only ". . . coding said audio information signal into a plurality of digitally compressed representations;. . . ." In our view,

the Examiner is correct in asserting that the splitting of a speech signal into a plurality of subbands and the dynamic distribution of coding bits over the subbands as described at col. 4, line 39 to col. 5, line 20 of Galand provides an explicit teaching of this feature.

As to Appellant's arguments concerning the claim language relating to the mitigation of audio degradation, we take note of the fact that such language appears only in the preamble of claim 9. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. In re Hirao, 535 F. 2d 67, 190 USPQ 15 (CCPA 1976).

For at least the above reasons, the Examiner's 35 U.S.C. § 102(b) rejection of claim 9 as anticipated by Galand is sustained. As discussed previously, since Appellant has grouped claims 9-13 and 22-26 together but has provided no separate arguments with regard to any of the claims in the group, the remaining claims in this group fall along with

claim 9. Accordingly, the Examiner's 35 U.S.C. § 102(b) rejection of claims 10-13 and 22-26 is sustained as well.

We now consider the 35 U.S.C. § 103 rejection of claims 1-26 as being unpatentable over the combination of Hluchyj and Galand. At the outset, we note that, from our earlier discussion, it is our opinion that a prima facie case of anticipation with respect to claims 9-13 and 22-26 has been established since the Examiner has demonstrated that all of the element of representative claim 9 are present in Galand. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982);
In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, we sustain the examiner's rejection of appealed claims 9-13 and 22-26 under 35 U.S.C. § 103.

With respect to the obviousness rejection of claims 1-8 and 14-21 based on the combination of Hluchyj and Galand, we note that in rejecting claims under 35 U.S.C. § 103, it is

incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825

(1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In making the obviousness rejection of independent claims 1 and 14, the Examiner seeks to modify the packet network communication system of Hluchyj which accepts and classifies audio information by relying on Galand to provide the missing teaching of selectively coding the audio information.

In response, Appellant has essentially reiterated the assertion that, since Galand teaches only multi-rate coding from a single coder, there is no disclosure of the

selective coding of an audio signal based on the signal characteristic. While we found Appellant's arguments concerning Galand to be unpersuasive with respect to independent claim 9 as discussed above, we reach the opposite conclusion with respect to independent claims 1 and 14. The relevant portion of claims 1 and 14 recites:

> selectively coding said audio information signal according to a coding algorithm associated with the characteristic.

After careful review of Appellant's arguments and the Galand reference, we are in agreement with Appellant that the Examiner has failed to establish a prima facie case of obviousness. In our view, the dynamic distribution of codes over plural subbands as described in Galand falls well short of disclosing the selective coding of an audio signal according to a signal characteristic sensitive coding algorithm as claimed.

We note that in the responsive arguments portion at page 5 of the Answer, the Examiner has responded to Appellant's arguments regarding the coding features in Galand by asserting the well known aspects of utilizing different coding

algorithms to code information signals. However, the Examiner has provided no support on the record for such assertion. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Our reviewing court requires this evidence in order to establish a prima facie case. In re Knapp-Monarch Co., 296 F.2d 230, 232, 132 USPQ 6, 8 (CCPA 1961); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

Since, for all of the reasons discussed above, we are of the opinion that the prior art applied by the Examiner does not support the obviousness rejection, we do not sustain the 35 U.S.C. § 103 of independent claims 1 and 14. Therefore, we also do not sustain the rejection of dependent claims 1-8 and 15-21.

In summary, the 35 U.S.C. § 102(b) and 35 U.S.C. § 103 rejections of claims 9-13 and 22-26 are sustained. The 35 U.S.C. § 103 rejection of claims 1-8 and 14-21 is not sustained. Accordingly, the decision of the Examiner rejecting claims 1-26 is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

STANLEY M. URYNOWICZ, Jr. Administrative Patent Judge	)
LEE E. BARRETT Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH F. RUGGIERO Administrative Patent Judge	)

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